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Please find below and/or attached an Office communication concerning this application or proceeding.

Response to Reply Brief

For the purposes of ease of comparison, the examiner's response to the reply brief filed October 28, 2003 will follow along the same titles as that used by the appellant.

With respect to the issues regarding claim 6, since claim 5 has been canceled and claim 6 is not on appeal, the appeal referencing claim 6 has been dismissed.

With respect to the other concern by the Board, that Anderie '63 may read on claims 1 and 26, if read as determined by the Board members, there would be no sole that would be separate from the torsion system, i.e. the torsion system and the sole would be one in the same. The claims clearly call for "a torsion system for a cycling shoe including a sole with a forefoot area and a rearfoot area, the torsion system including...". This places the sole on the shoe and the torsion system being separate from the sole. Although the cycling shoe may be stated in intended use fashion, it clearly claims a sole with a forefoot area and a rearfoot area on the shoe, thereby breathing life into the claim.

Argument

I. Response to section: Claims 1, 8-11, 15-17, 19-21, 24 and 26 constitute nonobvious subject matter and are patentable over Anderie (U.S. Patent No. 4,922,631) in view of Dubner (U.S. Patent No. 3,903,621) and Kraeuter et al. (U.S. Patent No. 5,915,820)

B. The cited references, alone or in proper combination, do not render claims 1, 8-11, 15-17, 19-21, 24 and 26 obvious and unpatentable under 35 U.S.C. § 103(a).

Appellant argues the interpretation of Figure 6, Appellant continues to argue that the limb portions 114, 115, and 116 do not extend beyond the surface of the rectangle shown in Figure 6. This argument is still not clearly understood, as the claim only requires that the rib project "beyond an adjacent surface of the torsion system" (emphasis added) and does not require the rib to project beyond all surfaces of the torsion system. Since the ribs project beyond the adjacent valleys between

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each rib (section 113), they meet the limitations as claimed. It appears that appellant is arguing more than that which is claimed.

4. Response to: The cited references, alone or in proper combination, do not render claim 1 unpatentable under 35 U.S.C. § 103(a).

Appellant argues that Dubner teaches that the envelope does not extend under the forefoot area of the foot, i.e. the ball of the foot. This argument is not clearly understood. The envelope 25 of the invention has attached to it a second envelope 26. This second envelope is the envelope referred to in Dubner that does not extend to the forefoot area, not envelope 25 which is shown in Figure 1. In col. 5, lines 3-7, Dubner clearly teaches that the top innersole element extends from the general area of the ball of the foot to the heel. Therefore, since the ball area of the foot denounces where the toe area begins, the support of Dubner is said to extend from the toe area to the heel. There is no requirement in the appellant's claims that the support extend **into** the toe area, only that it extend **to** a toe area. Therefore, Dubner teaches the extension of the support as claimed by the applicant.

Regarding the second issues argument, appellant's argument is also not clear. Appellant states that "the examiner's reliance on Dubner necessarily implicates all elements of the reference, not just an extent of the supportive insole. This argument is also not clearly understood. Dubner teaches that the support in a shoe can extend from the heel to the toe area of the foot to aid in giving support to the user's foot. Whether the support is flexible or not, Dubner teaches the desire for the extension of the support for the user's foot. As support for the user's entire foot in Kraeuter et al. and Anderie would also be desirable, this combination of the references is clearly proper for the reasons given.

With respect to appellant's arguments directed to Kraeuter et al., this argument was approached in the Examiner's Answer and will not be repeated here.

Regarding the appellant's arguments directed to hindsight reasoning, appellant has not given any showing of this reasoning separate from what was already discussed in the Examiner's Answer.

5. Response to: The cited references alone or in proper combination, do not render claim 8 unpatentable under 35 U.S.C. § 103(a).

Appellant continues to argue that the limb portions 114, 115, 116 do not extend beyond the surface of the elongate bar. Response to this argument has been stated over many times and the same argument applies here. The claim only requires that the rib project “beyond **an adjacent surface of the torsion system**” (emphasis added). Since 114, 115 and 116 extends beyond surface 113, it therefore meets the claimed limitations. They also define “at least one aperture” in the bar, i.e. that area between the bar extensions. It appears that appellant is arguing more than that which is claimed as appellant argues that they do not define “holes” rather than apertures, as claimed.

6. Response to: The cited references, alone or in proper combination, do not render claim 9 unpatentable under 35 U.S.C. § 103(a).

Appellant argues that the examiner’s statement that “all portions of the Anderie stiffening unit would be fastened together to function as a single unit, thereby meeting the single plate limitation” and states that the “Examiner’s statements in the Answer regarding Anderie alone are insufficient to justify a combination of these references...”. This argument is not clearly understood. In the Examiner’s Answer, the examiner stated that “Since all the portions of the stiffening elements used in the rejection of claim 9 would be fastened together to fully function as a single unit, they would meet this limitation in the claim as they would be able to perform the same function as a unit made of a single, unitary piece.” Nowhere does the examiner state anything about Anderie alone on page 12 of the Examiner’s answer.

7. Response to: The cited references, alone or in proper combination, do not render claim 10 unpatentable under 35 U.S.C. § 103(a). (This also applies to sections 8-13 in the Reply Brief)

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Appellant argues about the examiner's response to appellant's arguments being solely directed toward Anderie. Since Anderie is the base reference and teaches the added limitations in the claims, the other references are not needed to teach this limitation, as it is already present in the base reference.

11. Response to: The cited references, alone or in proper combination, do not render claims 16, 17 and 19 unpatentable under 35 U.S.C. § 103(a).

See Examiner's Answer, page 15, paragraph B. 11, as this fully explains the difference in the hardness in the front rear and intermediate portions already responded to by the examiner. (See col. 8, lines 41-57 of Anderie). It appears appellant is arguing more than that which is claimed. The claim only requires that "the forefoot portion and rearfoot portion comprise material properties different than the intermediate portion". The above cited section of Anderie meets this limitation of the claim. It appears that appellant is arguing the intermediate portion being along the center line of the sole which is contrary to how the intermediate portion was defined in claim 1. As seen in Anderie, Figure 8, 118 is the front portion and 119 in the rear portion. Therefore, if the 118 and 119 are made of harder material than that of 109 (the intermediate portion), then the limitations of claim 20 are clearly met by Anderie. Whether these portions are above or below the line P-P is irrelevant, as they are harder than section 109, which connects 118 to 119.

12. Response to: The cited references, alone or improper combination, do not render claim 21 unpatentable under 35 U.S.C. § 103(a).

Appellant argues that the term "cycling shoe" breathes life into the claim. The examiner disagrees with this for two reasons. Firstly, the term "for a cycling shoe" is an intended use statement and since the cited art can be used to pedal a bicycle, it would meet this limitation in the claim. Secondly, appellant has failed to distinguish their claimed cycling shoe over a shoe with a sole, forefoot area and rear area. Since the references used each have these particular areas, they meet this limitation

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in the claim when given patentable weight. Furthermore, it appears appellant is arguing more than that which is claimed. Appellant argues functions of the shoe that are not part of the limitations of the claimed invention.

13-14. Response: With respect to these arguments, they have been either addressed above or in the Examiner's Answer and will not be repeated here.

II. A. Response to: The cited references, alone or in proper combination, do not render claims 23 and 25 unpatentable under 35 U.S.C. § 103(a).

With respect to appellant's argument that the examiner's arguments directed to claim 23 are improper because they are directed to Nagano et al. only, this argument is not clearly understood. Appellant continues to argue that the combination needs to be addressed when a teaching for modifying the base reference is used. Since Anderie is the base reference and that which is modified by the other references, the reference to Anderie is understood as being used as a shortcut explanation for the references as modified and applied to claim 21 and Nagano et al. is only further modifying the base reference and not the other modifying references.

Once again, the appellant argues that Nagano et al. teaches away from Kraeuter et al. This argument is still not clearly understood as explained in the Examiner's Answer. The combination used in the rejection was not to use the cleat of Nagano et al. in modifying Kraeuter et al. and it appears that appellant is arguing more than that which is claimed. Kraeuter et al. was used to teach the desire for concavity of the front portion of the sole and not flexibility with respect to the entire sole. Appellant argues that to consider all the references applied "in their entirety" would require merging **all** attributes of the references together. There is no requirement to merge all attributes of each and every reference

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applied together to form a whole unit. The concern is what is taught, as a whole, to one of ordinary skill in the art with these references in front of them.

III. A. 1. Response to: The cited reference, alone or in proper combination, do not render claims 1-4, 11-14 and 18 obvious and unpatentable under 35 U.S.C. § 103(a).

With respect to appellant's arguments that there are other factors that influence the angle of rotation in addition to the "torsional loads", this argument is not clearly understood. Appellant argues that the angle of rotation can be influenced by material properties and depends upon "design or application needs". This issue is discussed in the Examiner's Answer and will not be repeated here.

2. Response to: The cited references, alone or in proper combination, do not render claims 11-14 unpatentable under 35 U.S.C. § 103(a).

With respect to claims 11-13, appellant argues the combination of references argument which has been addressed many times above and will not be further addressed here. Since Anderie teaches a thickness that falls within the range claimed by the appellant, the limitations of the claims are met by Anderie.

With respect to appellant's arguments directed to claim 14, these arguments are not clearly understood. Figure 6 is a cross-section of Figure 8 and clearly shows the thickness of the intermediate portion being less than the front and rear portions. This can also be clearly seen in Figures 1 and 8 as these Figures clearly show the "thickness" of 111, 112 and 118, 119 being thicker, i.e. wider in the Figure, than that of the intermediate section as required by the claim.

Once again, the combination of the references is argued and the response will not be repeated here as it is noted above and in the Examiner's Answer.

3. Response to: The cited references, alone or in proper combination, do not render claim 18 unpatentable under 3 U.S.C. § 103(a).

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The arguments proffered in the Examiner's Answer apply here.

IV. A. 2. Response to: The cited references, alone or in proper combination, do not render claim 7 unpatentable under 35 U.S.C. § 103(a).

Appellant again argues isolation of references which has been approached and responded to in this response, and applies here, and will not be repeated.

#### Conclusion

Appellant sums up his arguments stating that there was no reason to properly combine the references. This argument is not clearly understood. A reason to combine the reference is given in the last sentence of each of the rejections set forth in the Final Office action. Appellant further states that "the Examiner, by his own admission, is given to highlighting one or a limited number of elements that are disclosed in a reference" and considers this hindsight reasoning. This argument is not clearly understood. The examiner clearly has shown what each reference teaches, although not everything that each reference teaches, what the base reference is lacking and the reasoning behind the combination of each reference with the base reference, thereby presenting a prima facie case as required.

Furthermore, appellant argues that the examiner is using hindsight reasoning for reconstruction. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Appellant further argues that since one of ordinary skill in the art would not seek to combine the reference because some of the attributes of the



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references are incompatible and therefore, the reconstruction is improper. The examiner asserts that a proper reason to combine has been given with respect to each and every rejection set forth in the Final Office Action and therefore, a prima facie case has been established. Appellant further asserts that the examiner's opinion is flawed because it does not only rely on the skill of one of ordinary skill in the art. Appellant fails to disclose any showing of this as the examiner has clearly shown reasons to combine each and every reference in the rejections set forth. Appellant's arguments with respect to isolation have been addressed earlier in this response and will not be repeated here.

In conclusion, the examiner has responded to each and every concern of the Board of Appeals and Interferences as well as responded to the Appellants arguments in the Reply Brief. For these reasons, it is believed that the rejections, as stated in the Final Office action, should be sustained.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony Stashick', is written over the typed name.

Anthony Stashick  
Primary Examiner  
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ADS